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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,632	01/28/2004	Louie V. Harrison III	331860.9US	3747

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WYATT, TARRANT & COMBS, LLP
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MEMPHIS, TN 38120-4367

EXAMINER

KILKENNY, PATRICK L

ART UNIT	PAPER NUMBER
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3732

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

NT

Office Action Summary

Application No.

10/766,632

Applicant(s)

HARRISON, LOUIE V.

Examiner

Patrick J. Kilkenney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-21 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-6, 8-21, and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-6, 8, and 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Wiesel (6,343,932). Wiesel discloses a unit package for carrying and applying a dental composite (Column 6, lines 5-18). The dental composite (16) is carried on a carrier film (12) with an enlarge central portion (14) that is covered by a film covering (18) that is releasably sealed to the carrier film adjacent the composite (Figs. 1 and 2). The cover is in direct contact with the composite and is designed with a surface of non-adhesive release material (Column 4, lines 53-58), and it is also disclosed that a non-adhesive release coating may be applied for easier release (Column 5, lines 1-4). The carrier film has (embrasure) tabs (22 and 24) laterally extending from the central portion that are able to fold under the central portion of the carrier film and wrap around the edges of the teeth with applied (Figs. 2 and 3). The unit packages can be made singly, or come in a plurality of adjacent packages in a long roll that can be individually cut out when needed (Column 3, lines 60-64). The carrier film can be translucent if light activation of the applied composite is necessary (Column 4, lines 21-24). The unit package also includes an outer strip (20), on which the carrier strip is disposed, and is releasably sealed to the adjacent cover.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel in view of Davie, Jr. et al. (4,125,190). Wiesel discloses the claimed invention with the exception of the cover being dome-like in shape and not being in direct contact with the composite. Davie, Jr. et al. discloses a cover (14) that is adjacent to and encloses carrying film (20) and is dome-like in shape and does not contact the substance (24) held within the defined pocket. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the cover of Wiesel with a dome-like cover that does not contact the dental composite, as taught by Davie, Jr. et al., so that the dental composite would not stick to the cover, and the use of non-adhesive cover materials or non-adhesive coatings could be eliminated from the design, which would decrease the complexity and price of manufacturing the unit package.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel. Wiesel discloses the claimed invention with the exception of having a third tab that is capable of folding under the central portion of the carrier film. It would have been

obvious to one having ordinary skill in the art at the time the invention was made to construct the assembly of Wiesel having a plurality of tabs, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 13 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel in view of Jacobs et al. (5,762,192). Wiesel discloses the claimed invention with the exception of using an cover that is opaque to actinic radiation that would cure a dental composite. Jacobs et al. discloses a packaging for curable materials (specifically for dental use) that is actinic to radiation that would cure said materials (see abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cover of Wiesel by making it actinic to radiation, as taught by Jacobs et al., so the dental composite held within would not be activated before use.

Claims 14-15, 21, and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel in view of Jacobs et al. as applied to claims 13 and 19 above, and further in view of Davie Jr. et al. Wiesel in view of Jacobs et al. discloses the claimed invention with the exception of the cover being dome-like in shape and not being in direct contact with the composite. Davie, Jr. et al. discloses a cover (14) that is adjacent to and encloses carrying film (20) and is dome-like in shape and does not contact the substance (24) held within the defined pocket. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the cover of Wiesel in view of Jacobs et al. with a dome-like cover that does not

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contact the dental composite, as taught by Davie, Jr. et al., so that the dental composite would not stick to the cover, and the use of non-adhesive cover materials or non-adhesive coatings could be eliminated from the design, which would decrease the complexity and price of manufacturing the unit package.

Wiesel in view of Jacobs et al. also does not disclose having a third tab that is capable of folding under the central portion of the carrier film. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the assembly of Wiesel in view of Jacobs et al. having a plurality of tabs, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel in view of Jacobs et al., in further view of Davie Jr. et al, as applied to claim 14 above, and further in view of Sawhney et al. (5,947,278). Wiesel in view of Jacobs et al. discloses the claimed invention with the exception of there being perforation between the unit packages. Sawhney et al. discloses packaged cups for dental compositions with perforations (182) between the individual packages. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the unit package of Wiesel in view of Jacobs et al., in further view of Davies, Jr. et al. with perforations between the unit packages, as taught by Sawhney et al., so the individual packages could be easily removed without having to use a cutting device. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel in view of Jacobs et al. as applied to claim 26 above, and further in view of Sawhney et al.

(5,947,278). Wiesel in view of Jacobs et al. discloses the claimed invention with the exception of there being perforation between the unit packages. Sawhney et al. discloses packaged cups for dental compositions with perforations (182) between the individual packages. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the unit package of Wiesel in view of Jacobs et al. with perforations between the unit packages, as taught by Sawhney et al., so the individual packages could be easily removed without having to use a cutting device.

Response to Arguments

Applicant's arguments filed 10/06/2006 have been fully considered but they are not persuasive. The applicant argues that the tabs (22 and 24) overly the patients inside and outside gums and not within the lateral embrasures. However, the tabs of the delivery package of Wiesel are capable of being wrap around the tooth in the medio-distal direction and occupy the dental embrasure. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184

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USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969. In this case, the reference of Davis simply teaches an alternative style of covering to be place above substance to be protected. This design choice is not specific to the applicant's invention. In regard to the reference of Jacobs, Jacobs specifically states that the packaging is to be used with dental devices (see background).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick J. Kilkenny whose telephone number is (571) 272-8684. The examiner can normally be reached on Mon-Fri, 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Patrick J. Kilkenny



Cary E. O'Connor
Primary Examiner